

More particularly, the Examiner took the position that applicants' previous arguments were not persuasive, arguing inter alia that applicants' could not rely on a finding of different properties because the respective advantage would "flow naturally from following the suggestion of the prior art". In this regard it is respectfully reiterated that applicants' fail to agree with the Examiner that a reasonable person of ordinary skill in the art would be motivated to incorporate a metal oxide pigment into the hair conditioning composition which is addressed in the teaching of *Dieing et al.*, especially since *Dieing et al.* seek to avoid build-up on the hair. As noted by the Examiner in her subsequent remarks "one skilled in the art would have reasonably expected zinc oxide of *Tanner et al.* to remain on the hair". Accordingly, the Examiner acknowledged that an incorporation of the zinc oxide of *Tanner et al.* into the hair conditioning preparation of *Dieing et al.* would reasonably be expected to result in build-up. It is well settled that there is no suggestion or motivation to make a particular modification if the respective modification would render the prior art invention being modified unsatisfactory for its intended purpose¹). Since the teaching of *Dieing et al.* specifically seeks to avoid a build-up on the hair and in light of the Examiner's acknowledgement that build-up would result if metal oxide pigments were incorporated in the composition of *Dieing et al.*, the modification of the teaching of *Dieing et al.* upon which the Examiner's arguments are based is clearly not suggested by the prior art and the motivation to do what applicants' have done is lacking.

In light of the foregoing and in light of applicants earlier remarks it is therefore respectfully requested that the rejection of The Examiner maintained the rejection of Claims 1 to 4 and 9 to 19 under Section 103(a) based on the teaching of *Dieing et al.* in view of the disclosure of *Tanner et al.* and of *George et al.* be withdrawn. Favorable action is solicited.

REQUEST FOR EXTENSION OF TIME:

A request for a two month extension of time is included in applicants' RCE Transmittal form. The requisite fee is covered by the credit card payment enclosed with the RCE Transmittal form.

1) Cf. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984).

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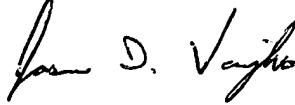
HÖSSEL et al.

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Respectfully submitted,

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